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First Named Inventor	Rabindranath Dutta
Art Unit	3627
Examiner Name	O Connor, Gerald J.
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ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
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- ☐ After Allowance communication to Technology Center (TC)
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- ☑ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
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Amended Appeal Brief (43 pages); 2 References; and Postcard

Remarks

The Comissioner is authorized to charge or credit Deposit Account No. 09-0447.

Customer No. 34533.

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Firm or Individual name	John Biggers Reg. No. 44,537
Signature	John Biggers
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Rabindranath Dutta	§	Group Art Unit: 3627
Serial No.: 09/915,438	§	Examiner: O Connor, Gerald J.
Filed: July 26, 2001	§	Atty Docket No.: AUS920010422US1
Title: Facilitating International Customs Planning	§	Customer No. 34533

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Date
Catherine Berglund
Catherine Berglund

AMENDED APPEAL BRIEF

Honorable Commissioner:

This is an Amended Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Notification of Non-Compliant Appeal Brief of January 13, 2006. The original Appeal Brief, which this filing amends, was filed on October 31, 2005, pursuant to 37 CFR § 41.37 in response to the Final Office Action of June 1, 2005 ("Final Office Action"), and pursuant to the Notice of Appeal filed August 31, 2005.

REAL PARTY IN INTEREST

The real party in interest in accordance with 37 CFR § 41.37(c)(1)(i) is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences within the meaning of 37 CFR § 41.37(c)(1)(ii).

STATUS OF CLAIMS

Status of claims in accordance with 37 CFR § 41.37(c)(1)(iii): Sixty claims are filed in the original application in this case. Claims 21-60 are withdrawn from consideration. Claims 1-20 are rejected. Claims 1-20 are on appeal.

STATUS OF AMENDMENTS

Status of amendments in accordance with 37 CFR § 41.37(c)(1)(iv): No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

SUMMARY OF CLAIMED SUBJECT MATTER

Applicants provide the following concise summary of the claimed subject matter according to 37 CFR § 41.37(c)(1)(v), including references to the specification by page and line number and to the drawings by reference characters. There is one independent claim in the present case, claim 1. Claim 1 is a method claim. Claim 1 claims:

1. A method for facilitating customs planning and clearance, the method comprising the steps of:

   creating in an international customs server, in response to a signal communicated through a client device coupled for data communications through at least one internet connection to the international customs server, a master customs planning record, wherein the master customs planning record comprises:

a master identification field in which is stored a master identity code for the master customs planning record, and

a duty total field in which is stored the total amount of duty to be paid on goods identified in related customs planning records;

creating in an international customs server a related customs planning record, wherein the related customs planning record is related through a foreign key field to the master customs planning record, wherein the related customs planning record comprises:

the foreign key field in which is stored the master identity code of the master customs planning record;

one or more description fields describing the goods for import to a destination country, the destination country having an identity;

a duty amount field in which is stored an amount of duty to be paid on the goods; and

the identity of the destination country;

calculating duty on the goods described in the related customs planning record;

storing the amount of the calculated duty in the duty amount field in the related customs planning record; and

incrementing, by the amount of the calculated duty stored in the duty amount field in the related customs planning record, the total amount of duty stored in the duty total field in the master customs planning record.

The portion of the original specification that is most pertinent to claim 1 of the present application is pages 13 – 22 and Figures 2, 5, 6. The subject matter of Claim 1 is summarized as follows with a description beginning at line 8 of page 13 in the original application. The reference numbers in parenthesis are reference characters of Figures 2, 5, and 6.

> Turning now to Figure 2, a further first aspect of the invention is seen as methods for facilitating international customs planning and clearance. A first embodiment illustrated in Figure 2 includes creating, in response to a signal (120) communicated through a client device coupled for data communications via an internet to an international customs server (160), a customs planning record (122) to be stored within the international customs server. The illustrated embodiment includes also creating (136) in dependence upon the customs planning record, a customs declaration form (162) for the destination country. The illustrated embodiment further includes submitting (164) the customs declaration form to a customs declaration forms database (148) for the destination country.
>
> In typical embodiments, customs planning records (122) comprise customs planning record forms (118), wherein the customs planning record forms (118) are dependent (144) upon customs regulations (114). More specifically, in order for the customs data in the customs planning records to be used, as it eventually is intended in typical embodiments, for creating declaration forms, the customs planning records record data pertinent to the customs declaration forms of the destination country for import of particular goods for a particular importer.

Turning now to Figure 5, a first aspect of the invention is seen illustrated as a method for facilitating customs planning and clearance. In typical embodiments, the method includes creating (502) in an international customs server (160), in response to a signal (510) communicated through a client device (104) coupled for data communications through at least one internet connection to the international customs server, a master customs planning record (402). In typical embodiments as illustrated in Figure 6, the master customs planning record includes a master identification field (630) in which is stored a master identity code for the master customs planning record, and a duty total field (634) in which is stored the total amount of duty to be paid on goods identified in related customs planning records.

In typical embodiments of the kind illustrated in Figure 5, the method also includes creating (108) in an international customs server (160) a related customs planning record (122), wherein the related customs planning record is related through a foreign key field (610) to the master customs planning record (402).

In typical embodiments of the kind illustrated in Figure 5, the method includes calculating (420) duty on the goods described in the related customs planning record. In typical embodiments, the method also includes storing the amount of the calculated duty in the duty amount field in the related customs planning record. In typical embodiments, the method further includes incrementing (420), by the amount of the calculated duty stored in the duty amount field in the related customs planning record, the total amount of duty stored in the duty total field in the master customs planning record.

Turning back to Figure 5, in typical embodiments of the invention each related customs planning record typically represents a prospective importation into a destination country of a quantity of goods of a category. Typical embodiments of the kind illustrated include creating (136), in dependence upon the related customs planning record, a customs declaration form (162) for a destination country and submitting (164) the customs declaration form to a customs declaration forms database for the destination country. Typical embodiments also include submitting (404), to the customs service (406) of the destination country, payment of the duty.

In the embodiment illustrated in Figure 6, at least one master customs planning record (402) is related 'one-to-many' to one or more related customs planning records (122). The relationship in the illustrated embodiment is implemented through a master record identification code (630) in the master customs planning record and a foreign key field (610) in the related customs planning record. The master customs planning record include a duty total field (634) in which is stored, in typical embodiments, a total amount of duty for one or more of the related customs planning records to which a master customs planning record is related. That is, in typical embodiments, related customs planning records include duty amount fields (622) in which is stored an amount of duty calculated for importation of goods described in the related customs planning records, and a running total of the amounts of duty in a multiplicity of related customs planning records is stored in a duty total field in the master customs planning record to which the related customs planning records are related.

In typical embodiments, as illustrated in Figure 6, the related customs planning record includes the foreign key field (610) in which is stored the master identity code of the master customs planning record, one or more

description fields (614, 616, 618) describing the goods for import to a destination country, the destination country having an identity, a duty amount field (622) in which is stored an amount of duty to be paid on the goods; and the identity of the destination country (620).

GROUNDS OF REJECTION

The grounds of rejection to be reviewed on appeal in accordance with 37 CFR § 41.37(c)(1)(vi) are these two:

1. Whether claims 1-6 and 11-20 are unpatentable under 35 U.S.C § 103(a) over Pool in view of Design Choice.

2. Whether claims 7-10 are unpatentable under 35 U.S.C § 103(a) over Pool in view of Seigel.

ARGUMENT

Applicants present the following arguments pursuant to 37 CFR § 41.37(c)(1)(vii) regarding the two grounds of rejection in the present case.

Argument Regarding The First Ground Of Rejection: Whether claims 1-6 and 11-20 are unpatentable under 35 U.S.C § 103(a) over Pool in view of Design Choice

Claims 1- 6 and 11 - 20 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Pool, U.S. Patent No. 6,460,020, in view of Design Choice.

'Design Choice' refers to the concept of ordinary skill in the art as applied in the Office Action, rather than an additional reference as such. In arguing that "respective custom

planning records each individually comprising all of the specific data elements as claimed" are disclosed or suggested by such ordinary skill in the art, the Office Action states on page 3:

> However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

The Office Action explains further at page 6, paragraph 8:

> The rejection is based on *design choice*, which is to say that, while the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, the method of Pool et al. is not disclosed as having the respective customs planning records each individually comprise all of the respective data elements as claimed by applicant. However, because there is nothing special (non-obvious) about storing the information in a data structure such as the applicant's claimed invention, as compared to storing the same information in a different data structure/arrangement, such as disclosed by Pool et al., the difference is considered obvious (non-patentably distinct) to one of ordinary skill in the art, because one of ordinary skill in the art would be readily and easily able to make the change, with neither undue experimentation, nor risk of unexpected results, which is the main test for obviousness/non-obviousness.

Emphasis added. The ordinary skill so described is referred to in this Response as 'Design Choice.' As will be shown below, however, Pool in view of Design Choice neither teaches nor suggests a method for facilitating customs planning and clearance as claimed in the present application. Claims 1-6 and 11-20 are therefore patentable and should be allowed.

Claim Rejections Under 35 U.S.C. § 103

To establish a prima facie case of obviousness, three basic criteria must be met. MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974).

The rejection of claims over Pool in view of Design Choice relies upon disclosure or suggestion in Pool of several of the elements of claim 1, whereas in fact, Pool does not disclose or suggest those elements. The proposed combination of Pool and Design Choice therefore cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application. In addition, as shown in more detail below, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations.

The Office Action Fails To Provide The Applicants With Information Sufficient To Judge The Propriety Of Continuing Prosecution As Required By 35 U.S.C. § 132

The Office Action cites Pool in an omnibus fashion, with no specific references to any portion of Pool asserted to disclose or suggest any element of a claim of the present application. The effect of this omnibus rejection is to make it practically impossible for Applicants to respond meaningfully to the rejections or to determine how to proceed in prosecuting the present case.

The contents of a proper 35 U.S.C. § 103 rejection include the relevant teachings of the prior art relied on, preferably including reference to the relevant column or page numbers and line numbers where appropriate. MPEP § 706.02(j)(A). More particularly, 35 U.S.C. § 132 requires the Examiner to notify the applicants of the reasons for rejections, including "such information and references as may be useful in judging of the propriety of continuing the prosecution ... ." 37 CFR 1.104(c)(2) second sentence requires, "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on *must* be designated as nearly as practicable." MPEP 707 requires, when needed for compliance with 35 U.S.C. § 132, the inclusion in the Office Action of " ... the particular figures(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s) ... ." MPEP 707.07(d) warns against omnibus rejections as, " ... stereotyped and usually not informative and should therefore be avoided."

The Office Action beginning at line 3 of page 3 sets forth the omnibus rejection of most of the elements of claim 1 over Pool, quoted above. This reference to Pool in the Office Action makes no mention of where in Pool the information relied on by the Examiner may be found. Pool describes, among other things:

- international shopping operations
- carrying out an international commercial transaction

- selecting a language from a menu in which to view catalog information on products
- selecting a currency from a menu in which to obtain price information
- selecting a product to be purchased and a destination for shipping such product to be purchased
- accessing at least one local or remote database for obtaining price information for the product to be purchased
- product codes for an international goods classification system
- international shipping information related to origination points of products and destinations
- receiving an order for products thereby triggering an electronic process for confirming existence of available funds
- accepting orders upon confirmation of availability of funds
- using customer information to select a currency and determining an exchange rate based upon the determined currency and a predetermined exchange medium
- determining whether the product to be purchased in fact involves an international transaction
- determining a shipping route and calculating associated costs
- arranging for shipment of a product along a shipping route selected by a customer
- correlating movement of an electronic record with movement of a product along a selected shipping route
- generating documents from an electronic record when appropriate along a selected shipping route
- authorizing electronic payment of expenses required along a selected shipping route
- storing and analyzing data based upon each customer accessing the system to develop a purchasing profile for each customer
- using a customer's purchasing profile to select a candidate product to be presented to the customer

Clearly Pool is a complex reference containing information regarding many technical subjects and other inventions. In this circumstance, it is important for the Examiner to provide some indication of where in Pool the Examiner believes elements of Applicants' claims to be disclosed or suggested in order for Applicants to have enough information to judge how or whether to continue the prosecution of the present application. Moreover, in the absence of any indication of where within Pool the Examiner believes elements of Applicants' claims to be disclosed or suggested, Applicants cannot understand the reasons for the rejections.

For these reasons alone, the rejection of the claims should be reversed, and the claims should be allowed. Despite the difficulty of responding to the rejections, however, in an effort to move the case forward and without prejudice to their request that the rejections should be reversed, Applicants undertake to make their best guess regarding the meaning of the Office Action and respond below as best they can under the circumstances.

Pool in view of Design Choice Neither Discloses Nor Suggests The Limitations Of The Present Claims

As mentioned above, it is not possible to know from the Office Action how or why the Examiner believes that Pool discloses or suggests elements of the claims of the present application. What Pool in fact does disclose, however, is a "UNIVERSAL SHOPPING CENTER FOR INTERNATIONAL OPERATION." Pool, Title Block (54). (All the following references are to Pool.) The principal object of Pool is described in column 2, lines 60-63 as:

> ... to consolidate all the disparate components of an international sale into one program whereby a buyer can go shopping by computer almost anywhere in the world.

In fact, the overall disclosure of Pool is that of a purchasing system, not a method of customs planning and clearance as claimed in the present application. The introduction of the Detailed Description in Pool at column 3, lines 60-66, states, for example:

> The design of the international shopping and transaction system of the present invention creates a seamless order entry system for shopping ... for both national and international transactions for the purchase of goods and services.

For further examples of Pool's disclosure of a purchasing system, please consider the following excerpts:

- In particular, the present invention is directed to the facilitation of international purchasing of goods ... addressing all aspects of such transactions. (column 1, lines 11-13, describing the TECHNICAL FIELD of Pool)

- customer information, including credit and financial data, as well as purchasing records and profiles (column 4, lines 18-19)

- A foreign vendor whose products are about to be purchased by the customer could be paid through an electronic clearing house that has received clearance from the clearing house in the customer's country. (column 10, lines 3-7)

- Such information can later be used to guide customers to catalogues or products related to previous purchases, as well as previously selected languages and currencies. (column 12, lines 5-53)

- Further, by providing an electronic title as the commercial invoice, the documentation flow is facilitated, costs reduced and the customer receives proof of purchase in a more timely fashion. (column 12, lines 64-68)

- Therefore until a pattern of purchases of like goods or services is defined between the two parties or geographic regions each transaction is unique in and unto itself. (column 13, lines 36-39)

- Our example will be a new automobile purchased from a local dealer by an export company for resale to a buyer located in the Netherlands. (column 14, lines 19-21)

Clearly the entire focus of Pool is to disclose a purchasing system. Pool does mention customs and customs clearance procedures, but only in the context of international purchasing operations according to the system of Pool. Pool in the paragraph beginning at column 11, line 53, for example, discloses:

- a commercial entity which specializes in moving the papers from the carrier to the customs department of the destination country ...

- goods can be transferred directly from the international carrier official by system operator to the national customs departments of the destination country ...

- Preferably, the electronic documentation will be presented to the customs officials ...

- Transfer of funds can be made electronically to the national customs service ...

And so on, showing that customs procedures are mentioned in Pool only incidentally to purchasing procedures. To the extent that Pool makes any mention of customs procedures, such mentions never disclose or suggest anything related to facilitating customs planning and clearance with an international customs server as claimed in the present application. As further evidence of the lack of disclosure or suggestion in Pool

regarding facilitating customs planning and clearance as claimed in the present application, please note that not one of the following terms or phrases from claim 1 of the present application occurs anywhere in Pool, not even once:

- facilitating customs planning
- facilitating customs planning and clearance
- customs planning record
- master customs planning record
- related customs planning record
- international customs server
- signals communicated through a client device

Clearly in these circumstances there is no sound basis for believing that Pool in any way discloses or suggests any element or limitation of the claims in the present application, and the Office Action points to no evidence in Pool on which to base any other conclusion. This Appeal Brief sets forth several reasons to reverse the rejections of the claims in this case, but this one reason alone – that Pool neither discloses nor suggests the elements it is purported to disclose or suggest – is sufficient for reversal.

The Theory of Inherency Is Not Available As A Basis For Rejection Of Claims In The Present Case

The Office Action at page 3, regarding Pool, states:

> ... and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ...

That is, the Office Action invokes the theory of inherency as a basis for rejection of elements of claim 1 in the present application. The Office Action takes the position in

effect that some disclosure in Pool necessarily results in the claim elements recited above, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise .... The rejection, however, is not accompanied by the required analysis to support a rejection relying on inherency. Merely reciting the word "inherently" is insufficient basis for a rejection on the theory of inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) cited in MPEP § 2112. The Office Action does not demonstrate in any way that anything in Pool necessarily results in calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise. In fact, such inherency does not exist. Calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ... cannot properly be said within the meaning of *Ex parte Levy* to necessarily flow from any of the teaching in Pool.

In addition regarding inherency, the Office Action also states at page 8, paragraph 11:

> Elements are considered inherent when they are *necessarily* present. In this case, the invention of Pool et al. could not perform as disclosed without knowing/determining all of the recited elements of data/information. Therefore, the elements are indeed properly considered inherent.

Applicants submit in response that whether a reference would perform as disclosed without elements of the pending claims is not the test for inherency. The test as stated in *Ex parte Levy* is whether "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." The Office Action merely concludes that "... the invention of Pool et al. could not perform as disclosed without knowing/determining all of the recited elements ... ," with no description whatsoever of what it is within Pool that necessarily includes anything from the claims of the present application. The Examiner's

mere naked assertion that allegedly inherent claim elements are 'necessarily' present in a reference is not enough, and in this Office Action, there is not one word that provides any substantive support for the proposition that customs planning records and their structures as claimed in the present application necessarily flow from anything in Pool. For this reason alone, it is correct to conclude that Pool does not disclose or suggest elements of claim 1 in this case. For this reason alone, claim 1 is patentable and should be allowed.

Design Choice Is Not Available As A Reference

The Office Action rejects claims 1-6 and 11-20 of the present application under 35 U.S.C. § 103(a) as being unpatentable over Pool in view of Design Choice. Although 35 U.S.C. § 103(a) requires two references against a rejected claim, the Office Action does not cite a reference to combine with Pool against claims 1-6 and 11-20. Instead, the Office Action at page 3 rejects claims 1-6 and 11-20 under the following argument:

> ... Pool et al. do not specifically disclose that the respective customs planning records each individually, comprise all of the specific data elements, as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool, et al. so as to be stored in a specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Applicants take this assertion of the Office Action to be a statement that the customs planning records and their structures as claimed in claim 1 of the present application are not disclosed by Pool but would have been obvious to one of ordinary skill in the art. In Applicants' Response to the second office action, in the absence of any indication of what the Examiner meant by 'ordinary skill in the art,' Applicants, forced to guess, took the position that this rejection, based on 'ordinary skill' so described, was a rejection relying

on common knowledge or Well Known Prior Art according to the MPEP § 2144.03. The Examiner now advises, however, in paragraph 8 at pages 6-7 of the Office Action, that this rejection is not based on well known prior art according to MPEP § 2144.03, but instead:

> The rejection is based on *design choice*, which is to say that, while the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise, the method of Pool et al. is not disclosed as having the respective customs planning records each individually comprise all of the respective data elements as claimed by applicant. However, because there is nothing special (non-obvious) about storing the information in a data structure such as the applicant's claimed invention, as compared to storing the same information in a different data structure/arrangement, such as disclosed by Pool et al., the difference is considered obvious (non-patentably distinct) to one of ordinary skill in the art, because one of ordinary skill in the art would be readily and easily able to make the change, with neither undue experimentation, nor risk of unexpected results, which is the main test for obviousness/non-obviousness.

Emphasis added. Because the Examiner refers to it as 'design choice,' the ordinary skill so described is referred to in this Appeal Brief as 'Design Choice.' The Examiner uses Design Choice in effect as a second reference to combine with Pool in a 35 U.S.C. § 103 rejection. Such usage might conceivably be available for facts well known to those of ordinary skill that can be instantly and unquestionably demonstrated within the meaning of MPEP § 2144.03, but the Examiner advises that this use of ordinary skill does not avail itself of facts that can be instantly and unquestionably demonstrated under MPEP § 2144.03. If the Examiner is correct in the statement that this is not a use of facts instantly and unquestionably demonstrable under MPEP § 2144.03, Applicants then submit that the posture of the case is squarely under 35 U.S.C. § 103 which requires two references.

The Examiner therefore in this case has only one reference, Pool, which admittedly does not disclose all elements of claim 1. If claim 1 stands, all the claims on appeal stand. For this reason without more, all the present rejections should be reversed, and all pending claims should be allowed.

Well Known Prior Art Is Not Available As A Reference

The Office Action on page 3 states, regarding respective custom planning records each individually comprising all of the specific data elements as claimed:

> ... Pool et al. do not specifically disclose that the respective customs planning records each individually, comprise all of the specific data elements, as claimed. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims, simply as a matter of design choice, since so doing could have been performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Applicants take this assertion of the Office Action to be a statement that the customs planning records and their structures as claimed in claim 1 of the present application are not disclosed by Pool but would have been obvious to one of ordinary skill in the art. Applicants previously, in their Response to the second office action in the present case, took the position that the 'ordinary skill,' so described, referred to 'Well Known Prior Art' according to MPEP § 2144.03. The Examiner explains in this Office Action, however, at page 6, paragraph 8, that this rejection is not based on well known prior art according to MPEP § 2144.03 but is instead based on Design Choice as discussed above. With respect to the Examiner's position, Applicants continue to view the Examiner's argument from page 3 of the Office Action regarding design choice and ordinary skill to be reasonably

amenable to interpretation as an exercise in well known prior art according to MPEP § 2144.03.

Patent practitioners are accustomed to seeing examiners use the (properly evidenced) knowledge of persons of ordinary skill in the art to support the element of motivation to combine in a prima facie case of obviousness. It is important to note with repsect to the present issue, however that the Examiner does *not* so use ordinary skill. In this case, at page 3 of the Office Action, the Examiner uses ordinary skill as a source of disclosure of a claim element, the customs planning records and their structures from claim 1 of the present application. This is a very, very different thing from using ordinary skill as a basis for motivation to combine references. In this usage, the Examiner asserts in effect that no second reference is needed for this 35 U.S.C. § 103 rejection, because anyone of ordinary skill in the art would know as an unquestionable fact to use or make the claim elements, customs planning records and their structures, for facilitation of customs planning and clearance as claimed here. Applicants propose with respect, despite the Examiner's protestation to the contrary (in paragraph 8 on page 6 of the Office Action), that it is very difficult to escape the conclusion that this is an exercise in official notice of a fact capable of instant and unquestionable demonstration as being well-known in the art in accordance with MPEP § 2144.03.

Applicants respectfully propose that the claim elements of the customs planning records and their structures as claimed in claim 1 of the present application are not available to the Examiner in this case as Well Known Prior Art. According to MPEP § 2144.03, the Examiner may make use of Well Known Prior Art facts outside the record only if such facts are capable of instant and unquestionable demonstration as being well-known in the art. Well Known Prior Art, however, may not be substituted for facts which cannot be instantly and unquestionably demonstrated. As indicated in *In re Lee*, 277 F.3d at 1343-44, 61 U.S.P.Q. at 1433-34, the examiner's finding of whether there is a teaching, motivation or suggestion to combine the teachings of the applied reference must not be resolved based on "subjective belief and unknown authority," but must be "based on objective evidence of record." The court in *Lee* requires evidence for the determination

of unpatentability by clarifying that "common knowledge and common sense," as mentioned in *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549 (C.C.P.A. 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. *Lee*, 277 F.3d 1345, 61 U.S.P.Q.2d at 1435.

In this case, Applicants note with respect that the Examiner has made a mere naked assertion that a fact is well known in the prior art with absolutely no objective evidence of record and no expression of any reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. As mentioned, Well Known Prior Art may not be substituted for facts which cannot be instantly and unquestionably demonstrated. For these reasons, the Examiner in this case cannot have recourse to facts well known in the prior art and cannot base a prima facie case of obviousness on the idea that the reference claim element is well known in the prior art. Claims 1 is therefore patentable and should be allowed – as should all the claims depending from it.

No Suggestion or Motivation to Modify Pool

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Pool. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Pool must come from the teaching of the cited art itself, and the Examiner must explicitly point to the teaching within the cited art suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The only words in the Office Action regarding suggestion or motivation to modify Pool are found at page 8, paragraph 12:

> In this case, the motivation to modify the prior art would be found in the knowledge generally available to one of ordinary skill in the art.

These words present a bald conclusion, pointing to nothing in the knowledge generally available to one of ordinary skill in the art that might provide some basis for finding a motivation to modify Pool. Such a bald general assertion of knowledge generally available to one of ordinary skill in the art is not enough to form a basis for rejection. The Examiner must provide a reference to a particular basis within the cited art suggesting the proposed modification in accordance with *In re Surko* and the cases cited. In addition, the Office Action makes no mention whatsoever of any other evidence of suggestion or motivation to modify Pool, neither in Pool itself nor in Seigel. As such, no proposed modification of Pool can establish a prima facie case of obviousness. For this reason, the rejection of claim 1 should be reversed, and claim 1 and all claims depending from it should be allowed.

Pool Teaches Away From The Claims Of The Present Application

Pool actually teaches away from facilitating customs planning and clearance with an international customs server as claimed in the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.,* 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson,* 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). The present application claims a method of facilitating customs planning and clearance by use of an international customs server. As mentioned above, Pool does make some mention of customs in the context of a universal shopping center for international operation. Pool teaches a process for carrying out an international commercial transaction (column 17, lines 2-3) that, despite incidental awareness of

customs procedures, makes no mention whatsoever of facilitating customs planning and clearance with an international customs server as claimed in the present application – thereby teaching directly away from facilitating customs planning and clearance as claimed in the present application. Because Pool teaches away from facilitating customs planning and clearance as claimed in the present application, the proposed modification of Pool by Design Choice cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the Proposed Combination of Pool and Design Choice

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Pool. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Pool. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

There can be no reasonable expectation of success in a proposed combination of process for carrying out an international commercial transaction of Pool with the 'arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims' as Design Choice to produce facilitating customs planning and clearance as claimed in the present application. On the contrary, incorporating 'arranged any of the calculated and stored data elements of Pool, *et al.* so as to be stored in a specific arrangement/manner of the instant claims' upon the process for carrying out an international commercial transaction of Pool would clearly change the principle of operation of Pool – changing it from a process for carrying out an international commercial transaction to a method of facilitating customs planning and clearance. That is, the principle of operation of Pool, carrying out an international commercial transaction, is changed completely, and in fact will not function at all, with the addition of the exact arrangement of data elements as claimed in claim 1 and alleged to be Design Choice. The proposed modification of Pool by Design Choice therefore cannot possibly support a prima facie case of obviousness.

Pool Is Nonanalogous Art

Pool cannot be a reference against the claims of the present application because Pool represents nonanalogous art within the meaning of *In Re Horn*, *Clay*, and *Oeitker*. *In re Horn*, 203 U.S.P.Q. 969 (C.C.P.A. 1979), *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992), *In re Oeticker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The field of the inventors' effort in this case is facilitating customs planning with an international customs server. The present application claims, among other things, creating a master planning record in an international customs server, creating a related customs planning record in an international customs server, calculating duty on goods, storing the amount of the calculated duty, incrementing the amount of the calculated duty, and so on. The field of Pool is a universal shopping center for international operations, clearly not within the field of the inventor's endeavor in this case.

Because Pool is not within the field of the inventor's endeavor in this case, there can be no basis for believing that Pool as a reference would have been considered by one skilled in the particular art working on the relevant problem to which this invention pertains. That is, there would be no reason for an inventor concerned with facilitating customs planning with an international customs server to search for art regarding universal shopping centers. The two have nothing to do with one another. Pool as a reference therefore is not reasonably pertinent to the particular problem with which the inventors were involved in the present case and is not available as a reference against the present application. Applicants respectfully propose that for this reason without more the rejection of the pending claims 1-20 should be reversed, and the claims should be allowed.

Pool in Combination with Design Choice Cannot Support A Prima Facie Case Of Obviousness Against Claims 1-6 and 11-20

For the same reasons that Pool and Design Choice cannot support a prima facie case of obviousness against independent claim 1, the proposed combination of Pool and Design Choice cannot support a prima facie case of obviousness against dependent claims 2-6 and 11-20 under 35 U.S.C. § 103. Claim 1 stands rejected under 35 U.S.C. § 103(a) as being anticipated by Pool in view of Design Choice, but claim 1 is patentable for the reasons set forth above. Claims 2-6 and 11-20 depend from independent claim 1 and also stand rejected under 35 U.S.C. § 103(a) as being anticipated by Pool in view of Design Choice, but claims 2-6 and 11-20 are patentable for the same reasons that claim 1 is patentable.. Each of dependent claims 2-6 and 11-20 includes all of the limitations of independent claim 1. Because the rejection of claim 1 should be reversed, as shown above, the rejections of claims 2-6 and 11-20 therefore should also be reversed and these claims also should be allowed for the following reasons, all of which are explained in detail above in this Appeal Brief:

- the Office Action fails to provide the applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132;
- the proposed combination with Pool does not teach the asserted claim limitations;
- the theory of inherency is not available as a basis for rejection of claims in the present case;
- Design Choice is not available as a reference;
- Well Known Prior art is not available as a reference;
- there is no suggestion or motivation to modify Pool by combination with Design Choice;
- Pool teaches away from facilitating customs planning and clearance as claimed in the present application;
- there is no reasonable expectation of success in the proposed combination of Pool and Design Choice;

- Pool cannot be a reference against the claims of the present application because Pool represents nonanalogous art;
- as described in detail below, the *Graham* factors have not been considered, determined, or applied.

Argument Regarding The Second Ground Of Rejection:
Whether claims 7-10 are unpatentable under
35 U.S.C § 103(a) over Pool in view of Seigel

Claims 7 - 10 stand rejected for obviousness under 35 U.S.C. § 103(a) as being unpatentable over Pool in view of Seigel, U.S. Patent Application Publication No. 2001/0051876. To establish a prima facie case of obviousness, three basic criteria must be met. MPEP § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 U.S.P.Q. 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974).

The rejection of claims over Pool in view of Seigel relies upon disclosure or suggestion in Pool of several of the elements of claim 1, whereas in fact, Pool does not disclose or suggest those elements. The proposed combination of Pool and Seigel therefore cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of the claims of the present application. In addition, as shown in more detail below, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combinations.

The Office Action Fails To Provide The Applicants With Information Sufficient To Judge The Propriety Of Continuing Prosecution As Required By 35 U.S.C. § 132

Applicants argued in detail above regarding the first ground of rejection, Pool in view of Design Choice, that the Office Action fails to provide the applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132. Applicants incorporate that argument here, as though fully set forth here, as equally applicable to the second ground of rejection, Pool in view of Seigel.

Pool in view of Design Choice Neither Discloses Nor Suggests The Limitations Of The Present Claims

Applicants argued in detail above regarding the first ground of rejection, Pool in view of Design Choice, that Pool in view of Design Choice neither discloses nor suggest elements of the present claims on the basis that Pool has not been shown to disclose or suggest any of the elements or limitations of the claims at issue here. Applicants incorporate that argument here, as though fully set forth here, as equally applicable to the second ground of rejection, Pool in view of Seigel.

Seigel Is Nonanalogous Art

Seigel cannot be a reference against the claims of the present application because Seigel represents nonanalogous art within the meaning of *In Re Horn*, *Clay*, and *Oeitker*. *In re Horn*, 203 U.S.P.Q. 969 (C.C.P.A. 1979), *In re Clay*, 966 F.2d 656, 23 U.S.P.Q.2d 1058 (Fed. Cir. 1992), *In re Oeticker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The field of the inventors' effort in this case is facilitating customs planning with an international customs server. The present application claims, among other things, creating a master planning record in an international customs server, creating a related customs planning record in an international customs server, calculating duty on goods, storing the amount of the calculated duty, incrementing the amount of the calculated

duty, and so on. The field of Seigel is a personalizing, customizing, and distributing geographically distinctive products and travel information over the Internet, clearly not within the field of the inventor's endeavor in this case.

Because Seigel is not within the field of the inventor's endeavor in this case, there can be no basis for believing that Seigel as a reference would have been considered by one skilled in the particular art working on the relevant problem to which this invention pertains. That is, there would be no reason for an inventor concerned with facilitating customs planning with an international customs server to search for art regarding personalizing, customizing, and distributing geographically distinctive products and travel information. The two have nothing to do with one another. Seigel as a reference therefore is not reasonably pertinent to the particular problem with which the inventors were involved in the present case and is not available as a reference against the present application. Applicants respectfully propose that for this reason without more the rejection of the pending claims 7-10 should be reversed, and the claims should be allowed.

Pool in Combination with Seigel Cannot Support A Prima Facie Case Of Obviousness Against Claims 7-10

For the same reasons that Pool and Design Choice cannot support a prima facie case of obviousness against independent claim 1, the proposed combination of Pool and Seigel cannot support a prima facie case of obviousness against dependent claims 7-10 under 35 U.S.C. § 103. Claims 7-10 depend from independent claim 1. Each of dependent claims 7-10 includes all of the limitations of independent claim 1 from which it depends. Because the rejection of claim 1 should be reversed, as shown above, the rejections of claims 7-10 therefore should also be reversed, and these claims also should be allowed for the following reasons:

- the Office Action fails to provide the applicants with information sufficient to judge the propriety of continuing prosecution as required by 35 U.S.C. § 132;

- the proposed combination with Pool does not teach the asserted claim limitations;
- the theory of inherency is not available as a basis for rejection of claims in the present case;
- Design Choice is not available as a reference;
- Well Known Prior art is not available as a reference;
- there is no suggestion or motivation to modify Pool by combination with Seigel;
- Pool teaches away from facilitating customs planning and clearance as claimed in the present application;
- Pool cannot be a reference against the claims of the present application because Pool represents nonanalogous art;
- Seigel cannot be a reference against the claims of the present application because Pool represents nonanalogous art;
- as described in detail below, the *Graham* factors have not been considered, determined, or applied.

Argument Regarding Both Grounds Of Rejection:
The Graham Factors Have Not Been
Considered, Determined, or Applied

The following argument applies to both grounds of rejection in the present case, both the rejections of claims 1-6 and 11-20 over Pool in view of Design Choice and also the rejections of claims 7-10 over Pool in view of Seigel:

Establishing a prima facie case of obviousness for claims 1-6, 11-20, and 7-10 (which as pointed out above has not been accomplished) is not the end of obviousness analysis, it is the beginning. The rejection of claims 1-6 and 11-20 under 35 U.S.C. § 103 is deficient because the proper factual inquiries, the '*Graham* factors,' have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Because this case includes no evidence of secondary considerations, the Graham factors, the factual inquiries required by *Graham* in this case, are:

(A) Determining the scope and contents of the prior art;

(B) Ascertaining the differences between the prior art and the claims in issue; and

(C) Resolving the level of ordinary skill in the pertinent art.

The Office Action Makes No Determination
Of The Scope And Content Of The Prior Art

The Office Action makes no attempt to determine the scope and content of the prior art as required by *Graham v. John Deere*. The principal rationale for the rejection of claims in the present case is set forth beginning on the third line of page 3 of the Office Action:

> ... Pool et al. disclose a method for facilitating customs planning and clearance, the method comprising the steps of: creating a master customs planning record and a related customs planning record in at least one international customs server, in response to signals communicated through a client device coupled for data communications through at least one Internet connection to the at least one international customs server, and the method of Pool et al. includes, either inherently or explicitly, calculating and storing all of the recited data elements that the claimed master customs planning record and related customs planning record comprise ...

This statement amounts to a mere omnibus assertion that Pool anticipates the contents of claim 1 in the present case with not one word regarding the scope or content of Pool, not one reference to a page, paragraph, or line in Pool that would give Applicants, or anyone else, any idea what the Examiner believes is the actual scope and content of art disclosed in Pool or why or where anything in Pool discloses or suggests elements of the present claims. This practice of simply asserting that Pool anticipates, with no discussion of the

scope or content of the art represented by Pool, continues for the dependent claims throughout the Office Action:

- Regarding claim 3, at the bottom of page 3 of the Office Action, the Office Action states: " ... each related customs planning record of the method of Pool et al. represents a prospective importation into a destination country of a quantity of goods of a category."

  Applicants submit that this assertion in the Office Action is a particular example of the failure to determine the scope and content of the prior art because there is no 'related customs planning record' disclosed in Pool, and the Office Action offers no determination of the scope and content of the art disclosed by Pool as it relates to claim 3. In particular, there is no indication in the Office Action what in the scope or content of Pool might be considered by the Examiner to disclose or suggest a 'related customs planning record.'

- Regarding claims 4-6, at the top of page 4 of the Office Action, the Office Action states: "... the method of Pool et al. further comprises creating, in dependence upon the related customs planning records, a customs declaration form for a destination country, submitting the form to a customs declaration forms database for the destination country, and submitting, to the customs service of the destination country, payment of the duty."

  Applicants submit in response that none of these terms occur in Pool: 'related customs planning record,' 'customs declaration,' 'customs declaration form,' customs declaration forms database,' 'customs form,' or 'customs database.' The Office Action offers not one word of determination of the scope and content of the prior art represented by Pool as it relates to claims 4-6. In particular, there is no indication in the Office Action what in the scope or content of Pool might be considered by the Examiner to disclose or suggest a 'related customs planning

record,' 'customs declaration form,' or a 'customs declaration form database.'

- Regarding claim 11, second paragraph of page 4 of the Office Action, the Office Action states: "... Pool et al. disclose that the at least one Internet connection can be wireless."

  Applicants submit in response that neither the term 'Internet connection' nor the term 'wireless' occurs anywhere in Pool. The Office Action makes no attempt to determine the scope and content of the prior art in Pool as it relates to claim 11. In particular, there is no explanation what is in the scope or content of Pool that the Examiner believes may disclose or suggest elements of claim 11.

- And so on ... for each and every claim rejection in the entire Office Action.

An important concern regarding the determination of the scope and content of prior art is avoidance of impermissible hindsight. "The determination of the scope and content of prior art is to be determined at the time the invention was made to avoid impermissible hindsight." MPEP § 2141.01.III. "It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In effect, the Examiner in this case has found a U.S. patent that has something to do with international commerce and cited the entire reference in an omnibus rejection of all the claims of the present case – with not even a colorable pretense of determining the scope and content of the prior art. In this case, where the Office Action makes no determination whatsoever regarding the scope and content of the prior art, it is practically impossible to escape the conclusion that the Office Action represents a substantial exercise in impermissible hindsight.

The Office Action Does Not Ascertain The Differences Between The Prior Art And The Claims In Issue

The Office Action makes no attempt to ascertain the differences between the prior art and the claims in issue. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP § 2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The prototypical reference to Pool is the wording of the Office Action quoted above beginning in the third line of page 3 where the Office Action makes an omnibus reference to Pool with no attempt to ascertain in any understandable way any differences between Pool as prior art and the claims at issue in the present case. There is not one word in the Office Action making any attempt whatsoever to interpret the claims of the present application. There is nothing in the Office Action purporting to consider claim 1, or any other claim, as a whole. Indeed, when claim 1 is considered as a whole, it is seen to claim a method for facilitating customs planning and clearance with an international customs server, and Pool, a disclosure of a 'universal shopping center' would not even be considered analogous art against such a claim – taken as a whole.

The Office Action Does Not Resolve The Level Of Ordinary Skill In The Pertinent Art

The Office Action makes no attempt to resolve the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP § 2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 U.S.P.Q.2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman,

those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 U.S.P.Q. 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 U.S.P.Q. 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The Office Action fails to apply a single factor used to determine the level of ordinary skill in the art. In fact, the Office Action sets forth no analysis at all considering the level of one of ordinary skill in the art for the instant case. As discussed below in more detail, the Office Action places substantial reliance on the knowledge of a person of ordinary skill in the art. Applicants submit that in the complete absence of any resolution whatsoever of the level of ordinary skill in the pertinent art, it is absolutely impossible for anyone to make any determination whatsoever regarding whether the differences between the invention as claimed and the prior art disclosed or suggested in references would have been obvious to one of ordinary skill in the art at the time the invention was made.

For all these reasons, it is clear that the *Graham* factors have not been considered, determined, or applied in the present case. The rejections of the pending claims therefore should be reversed, and the claims should be allowed. Applicants set forth below several additional reasons to reverse the rejections of the claims in this case, but the failure to analyze the *Graham* factors alone is sufficient reason for reversal.

Conclusion

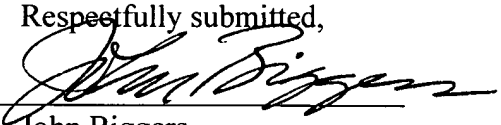
Claims 1-20 stand rejected under 35 U.S.C. § 103 as being obvious over Pool in view of Design Choice or Seigel. Neither Pool, nor Pool in combination with Seigel, nor Pool in combination with Design Choice, nor Pool modified by knowledge generally available to

one of ordinary skill in the art discloses nor suggests each and every element of Applicants' claims. Claims 1-20 are therefore patentable and should be allowed.

In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: February 13, 2006 By: 

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APPENDIX OF CLAIMS ON APPEAL IN PATENT APPLICATION OF RABINDRANATH DUTTA, *ET AL.*, SERIAL NO. 09/915,438

CLAIMS

What is claimed is:

1. A method for facilitating customs planning and clearance, the method comprising the steps of:

creating in an international customs server, in response to a signal communicated through a client device coupled for data communications through at least one internet connection to the international customs server, a master customs planning record, wherein the master customs planning record comprises:

a master identification field in which is stored a master identity code for the master customs planning record, and

a duty total field in which is stored the total amount of duty to be paid on goods identified in related customs planning records;

creating in an international customs server a related customs planning record, wherein the related customs planning record is related through a foreign key field to the master customs planning record, wherein the related customs planning record comprises:

the foreign key field in which is stored the master identity code of the master customs planning record;

one or more description fields describing the goods for import to a destination country, the destination country having an identity;

a duty amount field in which is stored an amount of duty to be paid on the goods; and

the identity of the destination country;

calculating duty on the goods described in the related customs planning record;

storing the amount of the calculated duty in the duty amount field in the related customs planning record; and

incrementing, by the amount of the calculated duty stored in the duty amount field in the related customs planning record, the total amount of duty stored in the duty total field in the master customs planning record.

2. The method of claim 1 wherein the one or more fields describing goods for import in the related customs planning records comprise:

a text description field in which is stored a textual description of the goods for import;

a category field in which is stored a code identifying the category of the goods for import; and

a quantity field in which is stored the quantity of goods for import.

3. The method of claim 1 wherein each related customs planning record represents a prospective importation into a destination country of a quantity of goods of a category.

4. The method of claim 1 further comprising creating, in dependence upon the related customs planning record, a customs declaration form for a destination country.

5. The method of claim 4 further comprising submitting the customs declaration form to a customs declaration forms database for the destination country.

6. The method of claim 1 further comprising submitting, to the customs service of the destination country, payment of the duty.

7. The method of claim 1 wherein the client device is a workstation in a kiosk at an airport.

8. The method of claim 1 wherein the client device is a workstation installed in the back of a passenger chair in an airplane.

9. The method of claim 1 wherein the client device is a personal computer.

10. The method of claim 1 wherein the client device is a hand-held personal data administrator.

11. The method of claim 1 wherein the at least one internet connection is wireless.

12. The method of claim 1 wherein the master customs planning record further comprises an importer identification field in which is stored an identity of an importer.

13. The method of claim 1 wherein the related customs planning record further comprises an importer identification field in which is stored an identity of an importer.

14. The method of claim 1 wherein the international customs server is a software application installed and operating on one or more computers, the software

application further comprising software routines storing and retrieving related customs planning records, validating goods described in related customs planning records against customs regulations stored in customs regulations databases, and submitting to customs databases declaration forms prepared in dependence upon the related customs planning records.

15. The method of claim 4 wherein creating in dependence upon the related customs planning record a customs declaration form for the destination country further comprises reading customs data from a related customs planning record and inserting the read customs data into a declaration form.

16. The method of claim 5 wherein submitting the customs declaration form to a customs declaration forms database for the destination country further comprises communicating the form as electronic data communications through at least one internet connection.

17. The method of claim 1 further comprising validating goods described in a related customs planning record.

18. The method of claim 17 wherein validating goods described in a related customs planning record further comprises comparing the goods described in the related customs planning record to customs regulations governing the goods described by the customs data in the related customs planning record and reporting to an

importer through the client device a result of the comparison.

19. The method of claim 18 further comprising storing the result of the comparison in the related customs planning record.

20. The method of claim 1 wherein the related customs planning record comprises a related customs planning record form having a structure, wherein the structure of the related customs planning record form is dependent upon customs regulations.

APPENDIX OF EVIDENCE
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, *ET AL.*, SERIAL NO. 10/022,624

This is an evidence appendix in accordance with 37 CFR § 41.37(c)(1)(ix).

There is in this case no evidence submitted pursuant to 37 CFR §§ 1.130, 1.131, or 1.132, nor is there in this case any other evidence entered by the examiner and relied upon by the appellants.

RELATED PROCEEDINGS APPENDIX

This is a related proceedings appendix in accordance with 37 CFR § 41.37(c)(1)(x). There are no decisions rendered by a court or the Board in any proceeding identified pursuant to 37 CFR § 41.37(c)(1)(ii).